

Remarks

New claims 3-5 have been added. Each of the new claims finds full support throughout Applicants' specification. More specifically, claim 3 finds exemplary support at page 11, lines 16-17. Claim 4 finds exemplary support at page 9, lines 12-20. Claim 5 finds exemplary support at page 10, lines 7-21. No new matter has been introduced by any of the new claims.

1. Rejection under 35 U.S.C. § 103(a)

A. Claim 1

Claim 1 is rejected as being unpatentable over U.S. Patent 6,348,519 to Ohshima *et al.* ("Ohshima"). The Examiner asserts that Ohshima teaches each of Applicants' claimed features except for the total solids content of the resin particles being in the range of from about 20 to about 80% by weight. According to the Examiner, it would have been obvious to a person of ordinary skill in the art to discover the claimed range through optimization experiments requiring only routine skill.

Applicants respectfully disagree with the Examiner's application of Ohshima as allegedly rendering obvious Applicants' claim 1. The Examiner states that Ohshima teaches Applicants' claimed feature of the content of the photo-curable resin relative to the total weight of the non-photo-curable resin and the photo-curable resin as being from about 10 to about 80%. The Examiner specifically cites to column 5, lines 56-60 of Ohshima as evidence of this teaching. A review of this section of the specification reveals that Ohshima describes the amount of the ultraviolet cure compound contained in the aqueous or organic phase, relative to the total weight of the ink, as preferably between three to 30 weight % if it is an oligomer and between three to 40 weight % if it is a monomer. This measurement is very different from Applicants' measurement of the amount of the photo-curable resin relative to the total weight of the non-photo-curable resin and the photo-curable resin, especially given that water can comprise up to 90% by weight of the Ohshima inks (see, *e.g.*, column 3, lines 39-47 and the Examples). Such disparate teachings for determining the amounts of resin components present in Applicants' claimed compositions versus Ohshima's described compositions would result in compositions with different properties. Therefore, Applicants' claimed compositions are not rendered obvious in light of Ohshima. Applicants respectfully request that this rejection be withdrawn. Because new claims 3-5 incorporate each of the features of claim 1, these claims are also not rendered obvious by Ohshima for at least the above-discussed reasons.

B. Claim 2

Claim 2 is rejected as being unpatentable over Ohshima in view of U.S. Patent 5,513,569 to Mathias ("Mathias"). The Examiner acknowledges that Ohshima does not disclose inkjet printing but cites Mathias as teaching that screen printing, which the Examiner asserts is taught by Ohshima, is equivalent to inkjet printing. Thus, according to the Examiner, it would have been obvious to a person of ordinary skill in the art to substitute screen printing for inkjet printing for the same purpose of printing an image.

Applicants respectfully disagree with the Examiner's use of Mathias in combination with Ohshima to render Applicants' claimed invention obvious. Mathias cannot remedy the deficiencies that are present in Ohshima as discussed above in section A. The combination of Ohshima with Mathias cannot therefore render obvious claim 2. Applicants request that this rejection be withdrawn.


2. Conclusion

Applicants believe that all grounds for rejection have been fully addressed and that the subject application is now in condition for allowance. Should the Examiner feel that there are any issues outstanding after consideration of this amendment, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,

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